

Toth et al.

S/N:10/765,618

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a tomographic system, and corresponding to claims 1-8.

REMARKS

The Examiner has identified two inventions in the pending claims. The Examiner's classification of the inventions include Group I consisting of claims 1-8 drawn to a tomographic system, and classified in class 378, subclass 4, and Group II consisting of claims 9-32 drawn to a system and method of object positioning, and classified in class 378, subclass 195. The Examiner indicated that inventions I and II were related as combination and subcombination.

It is well-established that "where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon restriction; i.e., separate classification, status, or field of search." MPEP §806.05(c).

While Applicant appreciates the Examiner's experience in classifying the identified inventions, Applicant believes that class 378, subclass 205 is a more appropriate classification for the identified inventions than the 378/4 and 378/195 respective classification/sub-classification afforded by the Examiner. Subclass 205, as set forth in the Manual of Patent Classification, is the appropriate subclass for inventions directed to "subject matter including means designed to aid in the alignment of source, object, or detector relative to one another." As each of the identified inventions is directed to subject matter that aids in determining the position of the object relative to the x-ray source and/or x-ray detector, it is believed that both inventions should be commonly classified in subclass 205.

Applicant does not believe that the inventions when commonly classified "have formed a separate subject for inventive effort" as required under MPEP §808.02. That is, the MPEP provides that restriction may be proper despite a common classification "when an explanation indicates a recognition of separate inventive effort by inventors." *Id.* The Examiner may show a separate status in the art "by citing patents which are evidence of such separate status, and also a separate field of search." *Id.* As the Examiner has failed to provide an explanation that indicates a recognition of separate inventive effort or patents evidencing such separate status, it is believed that the Examiner has failed to satisfy the requirement that the inventions have formed a separate subject for inventive effort.

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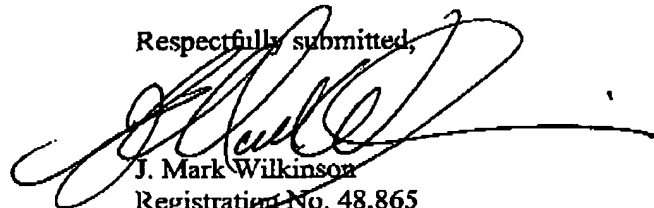
Additionally, the Examiner has failed to show that a different field of search is required for the identified inventions. Applicant submits that the search for invention I will necessarily entail a search of invention II, and vice-versa. Specifically, invention I includes "at least one sensor to provide subject-position feedback." Thus, a search of the elected invention will necessarily include a search of subject matter called for in claims 9 and 19 of invention II. While Applicant acknowledges that claims 9 and 19 call for limitations beyond the acquisition of subject-position feedback; nevertheless, any search of claims 9 and 19 would necessarily include the search for such a limitation, which is also found in claim 1 of invention I. Thus, it is believed that the Examiner cannot show that a different field of search is required for the pair of identified inventions.

Therefore, given that a common classification is more appropriate for the identified inventions and "the field of search is the same and there is no clear indication of separate future classification and field of search," it is believed that "no reasons exists for dividing among [the] related inventions." *Id.* For at least these reasons, Applicant respectfully requests rejoinder of all claims, of both groups.

Applicant has amended claim 1 to correct a typographical error.

The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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